REMARKS

This responds to the Office Action mailed on October 4, 2004.

No claims are amended, claims 22-32 are canceled, and no claims are added; as a result, claims 1-21 are now pending in this application.

Affirmation of Election

Restriction to one of the following claims was required:

As provisionally elected by Applicant's representative, Ann McCrackin, on September 23, 2004, Applicant elects to prosecute the invention of claims 1-21.

The claims of the non-elected invention, claims 22-32, are hereby canceled. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

In the Drawings

The drawings were objected to under 37 C.F.R. §1.84(f), and with regards to Figure 3, under 37 C.F.R. § 1.84(g). Applicant includes with this amendment and response clean copies of Figures 1-5 on sheets 1-5 respectively. Identifying indicia included on the front of each sheet consists of the title of the invention, the inventor's name, and the application number.

In addition, Figure 2 has been amended to include the reference character "225." Therefore, sheet 2, which includes Figure 2, is labeled as "REPLACEMENT SHEET."

Applicant respectfully submits that the submitted drawings, including the amendments, bring the drawings into compliance with 37 C.F.R. § 1.84. Applicant respectfully requests withdrawal of the objections to the drawings.

§102 Rejection of the Claims

Claims 8-10 were rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson (U.S. 6,782,264 B2). Applicant does not admit that Anderson is prior art, and reserves the right to swear behind this reference in the future. Applicant respectfully traverses the rejections of the claims 8-10.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

Applicant respectfully submits that the Office Action has failed to make out a prima facie case of anticipation in that Anderson does not teach each and every element of claims 8-10 as arranged in the claims.

For example, claim 8 recites, "a register circuit coupled to a processor <u>to monitor the number of successful and/or unsuccessful data communication links</u>." (emphasis added) In contrast, Anderson at column 18, lines 19-46, states, "The DSP module performs the following steps in automatic detection (see FIG. 2E-1): for each possible control and/or voice channel which may be used in the coverage area of the SCS 10, peg counters are established (step S7-1); at the start of a detection period, all peg counters are reset to zero (step S7-2); <u>each time that a transmission occurs in a specified RF channel, and the received power level is above a particular pre-set threshold, the peg counter for that channel is incremented</u> (step S7-3)." (emphasis added) Thus, Anderson fails to teach, "a register circuit coupled to a processor to monitor the number of successful and/or unsuccessful data communication links," as recited in claim 8.

The Office Action asserts that these elements are taught by Anderson at column 20, lines 10-15, which states, "The SCS 10 can also <u>monitor the number of times that transmissions have been successfully demodulated</u>, as well as the number of failures. This is useful in allowing operators to determine whether the signal thresholds for demodulation have been set optimally." (emphasis added) Applicant respectfully submits that the cited reference fails to teach, "a register circuit coupled to a processor to monitor the number of successful and/or unsuccessful

data communication links," as recited in claim 8. (emphasis added) Hence, Anderson fails to teach each of the elements of claim 8.

Claims 9-10 depend directly on claim 8, and are patentable over Anderson for the reasons argued above, plus the elements in the claims.

Therefore, Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 8-10.

Allowable Subject Matter

Claims 11-13 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant acknowledges and thanks the Examiner for the indication of allowability of claims 11-13 if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has not amended claims 11-13 to place them in independent form at this time. Pursuant to arguments presented above, Applicant respectfully submits that these claims are in condition for allowance. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the objection, and allow these claims.

Claims 1-7 and 14-21 were allowed. Applicant gratefully acknowledges the allowance of claims 1-7 and claims 14-21.

Documents Cited but Not Relied upon for this Office Action

Applicant need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action since these references are not made part of the rejections in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form part of future rejections.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/313,845
Filing Date: May 17, 1999
Title: METHOD FOR ESTABLISHING COMMUNICATION ON AN INTEGRATED SERVICES DIGITAL NETWORK
Assignee: Intel Corporation

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Dkt: 884.126US1 (INTEL)

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6970) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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                              Reg. No. 25,179

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 4th day of January, 2005.

_____Amy Moriarty_____   _____
Name   Signature

IN THE DRAWINGS

Corrected drawings sheets 1-5 are supplied herewith, with sheet 2 being labed as "REPLACEMENT SHEET."